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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/923,084 | 08/06/2001 | Keith Barraclough | 8X8S.125PA | 1753 |

7590 03/01/2004

Attention : Robert J. Crawford
Crawford PLLC
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St. Paul, MN 55120

EXAMINER

WINDER, PATRICE L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2155

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,084

Applicant(s)

BARRACLOUGH ET AL.

Examiner

Patrice Winder

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-11 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 of prior U.S. Patent No. 6,301,607 B1. This is a double patenting rejection.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 18 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,301,607 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the conflicting claims recite substantially the same functional limitations of the claims of the U.S. Patent No. 6,301,607 B1, including means-plus-function language.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayle et al., U.S. Patent No. 6,018,774 (hereafter referred to as Mayle) in view of Anupam et al., USPN 5,862,330 (hereafter referred to as Anupam).

8. Regarding claim 12, Mayle taught a method for displaying and sharing digital images using an internet access appliance with image capture capability, comprising the steps of:

posting at least one digital image via a server to a web page where the at least one image is made available for viewing (generating HTML pages that represent postcard and storing sent card in database, column 6, lines 5-13, column 5, lines 32-33), the at least one digital image being a digital image of an item captured by a sender (receiving graphic data for photos from several devices, column 7, lines 7-16);

selecting a least one individual for whom the at least one image is to be made accessible for viewing (senders selects recipients, column 13, lines 22-27); and

notifying the at least one individual of the at least one image being posted to the web page (notifying recipients of a waiting postcard, column 12, lines 51-55).

Mayle does not specifically teach using the Internet access appliance to establish a telephony connection between said at least one individual and a second individual, where the at least one individual and the second individual concurrently review the at least one image at the web page. However, Anupam taught while viewing at least one image (column 2, lines 47-52), using the Internet access appliance to establish a telephony connection between said at least one individual and a second individual (column 4, lines 30-36, column 5, lines 13-20), where the at least one individual and the second individual concurrently review the at least one image at the web page (column 4, lines 12-15). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Anupam's collaborative browsing in Mayle's

system for generating web pages for sharing images would have improved system effectiveness. The motivation would have been to provide users with the option of building a more interactive communication session while sharing information.

9. Regarding dependent claim 13, Mayle taught the method further comprising:

prior to posting the at least one digital image via the server to a web page, downloading the at least one digital image to the Internet access appliance (uploading graphical data by user computer 10, column 7, lines 7-8);

sending the at least one digital image to a server (transferring photo as an email attachment, column 10, lines 46-50).

10. Regarding dependent claim 14, Mayle taught downloading the at least one digital image to the Internet access appliance includes downloading the at least one digital image directly to a network storage arrangement via the Internet access appliance (uploading graphical data through user computer 10, column 7, lines 7-8).

11. Regarding dependent claim 15, Anupam taught the internet access appliance has internet telephony capability (column 2, lines 33-34), wherein establishing a telephony connection between said at least one individual and a second individual includes establishing an internet telephony connection between the at least one individual and the second individual (column 4, lines 30-36, column 5, lines 13-20).

12. Regarding dependent claim 16, Mayle taught further comprising establishing access to the posted at least one digital image to a plurality of individuals, wherein any first one of the plurality of individuals is the selected at least one individual, and wherein

any second one of the plurality of individuals is the second individual (column 13, lines 22-27).

13. Regarding dependent claim 17, Anupam taught the second individual is the sender (sender = creator, column 2, lines 25-33, column 4, lines 27-36).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Fredlund et al., USPN 5,666,215: taught viewing photographic image at a customers location on a personal computer and images can be selected for initial printing, reprinting, and ordering related image services;
- b. Hong et al., USPN 5,710,883: taught a method is disclosed for publishing a hypertext field set one a world-wide web server machine by packaging the hypertext file set as an e-mail message;
- c. Moghadam et al., USPN 5,799,219: taught digitizing images developed on film and transmitting the digitized images to the customer selected electronic addresses;
- d. Sonnenreich et al., USPN 5,974,446: taught a server enabling real-time intercommunication between a plurality of users;
- e. Sklar, USPN 6,025,843: taught an internet appliance with internet telephone capability wherein clicking on an icon initiates an internet telephone call;

- f. Narayen et al., USPN 6,035,323: taught method and apparatus for distributing a collection of digital media over a network with automatic generation of presentable media;
- g. Wang et al., USPN 6,058,428: taught a method and apparatus for transferring digital images on a network, utilizing a signature list including a unique signature for each digital image;
- h. Wang et al., USPN 6,085,249: taught a method and apparatus for transferring image data in response to authentication information;
- i. Safai et al., USPN 6,167,469: taught a digital camera having display device for displaying graphical representation of user input and method for transporting the selected digital images to a destination;
- j. Grunsted et al., USPN 6,192,123 B1: taught a method and apparatus for initiating telephone calls using a data network;
- k. Khosla et al., USPN 6,202,061 B1: taught a method and system for creating a collection of digital media;
- l. Mattaway et al., USPN 6,275,490 B1: taught a method and apparatus for initiating an internet telephony connection from a web browser;
- m. McCullough et al., WO 96/37068: taught data conferencing between remotely located participants wherein documents to be shared during the conference are converted into a database of images;

- n. Cohen, WO 97/48050: taught a method and apparatus for connecting multiple users on an IP network without each user having to know the other's IP address;
- o. Yuichi Yagawa et al., The Digital Album : A Personal File-tainment System : taught a personal File-tainment system that allows users to enjoy multimedia data as well as file and retrieve them;
- p. Vassilis Athitsos et al., Distinguishing Photographs and Graphics on the World Wide Web: taught a photo detector that determines whether web images are computer generated or photographs that appear on the web based on statistical observations; and
- q. Stefan Schmid, Web Representation with Dynamic Thumbnails: taught generating dynamic thumbnail of web pages based on client requests.

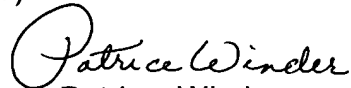
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 703-305-3938. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 703-308-3662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrice Winder
Primary Examiner
Art Unit 2155

plw